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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SANJAY PUJARE, ROBERT DEUEL, NICHOLAS RYAN,
MANUEL BENITEZ, and DAVID LIN

Appeal 2009-000027
Application 09/826,607
Technology Center 2400

Decided: October 27, 2009

Before HOWARD B. BLANKENSHIP, ST. JOHN COURTENAY III, and
STEPHEN C. SIU, *Administrative Patent Judges*.

COURTENAY, Administrative Patent Judge.

DECISION ON REQUEST FOR REHEARING

STATEMENT OF THE CASE

An oral hearing on this appeal was held on June 11, 2009. On August 31, 2009, Appellants filed a Request for Rehearing under 37 C.F.R.

§ 41.52(a)(1) (hereinafter “Request”) for reconsideration of our Decision mailed June 24, 2009 (hereinafter “Decision”).

Our Decision affirmed the Examiner’s rejection of claims 1-6, 8-19, 21-32, 34-45, and 47-52 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Eylon, Kumar, and Schmeidler.

Our Decision affirmed the Examiner’s rejection of claims 7, 20, 33, and 46 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Eylon, Kumar, Schmeidler, and Cheng.

We have reconsidered our Decision, in light of Appellants’ arguments in the Request for Rehearing, and we find no errors therein. We decline to change our prior Decision for the reasons discussed *infra*.

Appellants request reconsideration of Issues 2-4, as set forth on page 5 of our Decision. (*See* Request 2-9).¹ For convenience, we reproduce Issues 2-4 from page 5 of our Decision here:

2. Have Appellants shown the Examiner erred in finding that the combination of Eylon, Kumar, and Schmeidler teaches or suggests conversion of a conventionally coded application into a streaming application? (*See* claims 1 and 40).

¹ We note that in the Request Appellants do not contest Issue 1 (listed on page 5 of our Decision).

3. Have Appellants shown the Examiner erred in finding that the combination of Eylon, Kumar, and Schmeidler teaches or suggests installation monitoring means (as in recited claim 1), or monitoring an installation process and gathering modification information (as recited in claim 40)?
4. Have Appellants shown the Examiner erred in finding that the combination of Eylon, Kumar, and Schmeidler teaches or suggests parameterizing system registry modifications? (*See* claims 1 and 40).

Issue 2

Regarding Issue 2, Appellants contend that “conventionally coded” is used in the claims to refer to an application that is not stream-enabled (Request 2). Appellants further contend that even if “conventionally coded” were to be broadly interpreted to include *any* application, element 2 of claim 1 (i.e., “wherein said installation monitoring means gathers modification information including system registry modifications that said installation process makes to certain file paths in a system registry of said local computer system”) makes it impossible for the first application to be a stream-enabled application because storing, e.g., Eylon’s streamlets on the local computer system does not result in system registry modifications (Request 4-5). Appellants state that “[s]imply put, making an application appear to be installed requires that the registry modifications be made in advance of executing a stream-enabled application.” (Request 5)

As stated in our Decision, we broadly but reasonably construe an application as being “installed” if it is *stored for execution* in a computer system in any manner, even if the application is only stored for execution of one application code portion at a time (*e.g.*, as Eylon’s application “streamlets” that are downloaded and temporarily installed for execution in a dynamic fashion as required). (*See* Decision 13-14). Further, we note that the Examiner has relied on the Kumar and Schmeidler references for teaching or suggesting the claimed registry modifications associated with an application installation (Ans. 5-6, 13-14). Therefore, Eylon must be read, not in isolation, but for what it fairly teaches in combination with the prior art as a whole. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. *In re Merck & Co.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. *In re Keller*, 642 F.2d 414, 425 (CCPA 1981); *In re Young*, 927 F.2d 588, 591 (Fed. Cir. 1991).

This reasoning is applicable here. The Examiner’s rejection is based on the combination of cited references. Therefore, we find Appellants’ arguments unpersuasive and decline to modify our original Decision regarding Issue 2.

Issue 3

Regarding Issue 3, Appellants contend that “it makes absolutely no sense to say that the local computer system onto which a conventionally coded application is installed for the purpose of stream-enabling the application could be used as a streaming client for the very same application and the very same installation.” (Request 6, ¶1).

However, we conclude the record before us allows a broader reasonable construction. In support, we reproduce Appellants’ own statements regarding this issue made during the oral hearing held on June 11, 2009:

JUDGE COURTENAY: What do you mean by "a local computer system"? Is that the client or the server?

MR. AHMANN: In the case of -- in the case of when you have a stream-enabled application that's been claimed -

JUDGE COURTENAY: I'm looking at claim 1.

MR. AHMANN: Oh, in claim 1, it doesn't have to be a server or a client. It would -- it could happen at the server or it could happen elsewhere at a stream enablement computer and then the stream-enabled application could be provided to the server.

JUDGE COURTENAY: Okay. So the claim is broader then. It could happen either on the client or the server, according to what you just said.

MR. AHMANN. Yeah.

JUDGE COURTENAY: And a local computer system, just to be clear, can be either a server or a client -

MR. AHMANN: Yes, sir.

JUDGE COURTENAY: -- under your construction?

MR. AHMANN: It -- well, it sounds strange to call it a client because we are talking about streaming applications and if -- if you have an application that's being streamed, it is necessarily going to be streamed from a server to a client just because that's the way we refer to it.

But in this case we are preparing an application that can then be streamed, so, theoretically, you could prepare it at the client and then -- but it doesn't make much sense because you would send it to the server in order to stream it. *So it could be prepared on any -- any computer.*

JUDGE COURTENAY: Okay. So a local computer system could be any computer -

MR. AHMANN: Yes.

JUDGE COURTENAY: -- but, generally, in the preferred embodiment, once you have converted the conventional application into a streamed application, you are going to send it from the server to a client.

MR. AHMANN: Yes, sir.

(Official Transcript, oral hearing held on June 11, 2009, p. 5, l. 18 — p. 6, l. 24, emphasis added).

Thus, our broader construction is reasonable because Appellants have stated in the record that the application to be streamed “could be prepared on any -- any computer.” (*Id.* at 6, l. 17).

Appellants remaining arguments are again premised on what the proper interpretation of “installing” is (Request 5-8). In response, we restate our claim construction of this term, as discussed above (*See also* Decision 13-14). Because “applicants may amend claims to narrow their scope, a broad construction during prosecution creates no unfairness to the applicant or patentee.” *In re ICON Health and Fitness, Inc.*, 496 F.3d 1374, 1379 (Fed. Cir. 2007) (citing *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004)). This reasoning is applicable here.

Therefore, we find Appellants’ arguments unpersuasive and decline to modify our original Decision regarding Issue 3.

Issue 4

Regarding Issue 4, Appellants contend that Eylon does not teach or suggest the claimed monitoring means because Eylon does not monitor the installation of an application for the purpose of parameterizing system registry modification since that would mean that the application would not initially appear to be installed. (Request 9).

In response, we find that Appellants are again attacking Eylon in isolation, while not addressing what Eylon fairly teaches in combination with the prior art as a whole. As discussed *supra*, the Examiner has relied on the Kumar and Schmeidler references for teaching or suggesting the claimed registry modifications (Ans. 5-6, 13-14).

As stated in our Decision, Eylon expressly teaches that “[i]n configurations where the server autonomously streams data to the client, it is useful in making the selection of which streamlets to forward for the server to monitor the state of the client executed streamed application.” (Eylon, col. 12, l. 66 through col. 13, l. 2; *see also* Decision, p. 7 (FF 4) and p. 13). Therefore, based on our review of the evidence, we find Eylon (in combination with the other cited prior art) at least *suggests* the argued monitoring means, as claimed. We emphasize again that the Examiner looks to the Kumar and Schmeidler references for teaching or suggesting the claimed registry modifications. (*See* Ans. 13-14 and 17-18). Therefore, we find Appellants’ arguments unpersuasive and decline to modify our original Decision regarding Issue 4.

CONCLUSION

We have considered the arguments raised by Appellants in the Request for Rehearing, but find none of these arguments persuasive that our original Decision was in error. We are still of the view that the invention set

forth in claims 1-52 is unpatentable over the applied prior art based on the record before us in the original appeal. We have reconsidered our Decision but decline to grant the relief requested.

This Decision on Appellants' Request for Rehearing is deemed to incorporate our earlier Decision (mailed June 24, 2009) by reference. *See* 37 C.F.R. § 41.52(a)(1).

DECISION

We have granted Appellants' request to the extent that we have reconsidered our Decision of June 24, 2009, but we deny the request with respect to making any changes therein.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv). *See also* 37 C.F.R. § 41.52(b).

REHEARING DENIED

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